

REMARKS/ARGUMENTS

Claims 3 – 13 and 18 – 20 are pending in the application.

Claim 18 of the present application requires, among other features, that the liquid solution of capsicum in the solvent be brought to a maximum temperature of 64°C. This maximum temperature is extremely critical, since at 65°C or higher the terpenes are destroyed, as described, for example, on pages 8 and 10 of the specification of the instant application.

The Examiner has rejected, among others, claim 18 as being unpatentable over Etscorn in view of Negol. However, the Negol reference teaches treating capsicums with boiling hexane, i.e. at a temperature of at least 69°C, in other words at a temperature greater than the 64°C maximum required by Applicant's claim 18; such temperature would, of course, destroy the terpenes, thus not leaving an essential oil extract that contains capsaicinoid and terpene, again as required by Applicant's claim 18. Therefore, it is respectfully submitted that not only can there be no motivation for combining this reference with Etscorn, doing so would not even and could not even result in Applicant's method as defined in claim 18.

Furthermore, since the Negol reference utilizes a different mode of operation than does Etscorn, it is also not a proper reference pursuant to MPEP section 2143.01, the last paragraph of which indicates that a proposed modification or combination with the prior art is not sufficient to render claims prima facie obvious if such combination would change the principle of operation of the prior art invention being modified. The Examiner's attention is also directed to the previous portion of MPEP section 2143.01, which indicates that a proposed modification of a prior art reference can not render such prior art unsatisfactory for its intended purpose. Since

Etscorn contemplates retention of solvent in its extract, the total removal of the solvents as contemplated in Negol would render the Etscorn product unsatisfactory for its intended use. Therefore, on this basis also, there can be no suggestion or motivation to make the proposed modification of Etscorn in view of Negol.

As indicated above, Etscorn produces an extract that shares the properties of the solvent (see for example column 8, lines 37 – 39); thus, the Extract of Etscorn will have a high solvent content (by way of example, the examples show a solvent to habanero ratio of at least 2:1; see also column 8, lines 48 – 51). Thus, with regard to Applicant's claim 7, Etscorn clearly anticipates a retention of solvent, and in particular at far greater than the 1% limit contemplated by Applicant's claim 7. If, on the contrary, solvent was to be removed from the Etscorn product to less than a 1% level, clearly a temperature of at least 65°C would be required, and certainly much higher than that to remove the solvent having the highest boiling point, since Etscorn utilizes solvents that are a mixture of several compounds. However, in doing so, the terpenes would to a great extent be destroyed.

With regard to Applicant's claim 19, in view of the solvents used by Etscorn, to significantly reduce the solvent content it is respectfully submitted that it would be necessary to heat the solution in Etscorn to at least 75°C, which as already previously emphasized destroys the terpenes and therefore would also destroy a naturally occurring capsaicinoid to terpene ratio. In view of the high boiling points of the various solvents contemplated by Etscorn, it is respectfully submitted that Etscorn in no way addressed or otherwise gave consideration to the retention of a naturally occurring capsaicinoid to terpene ratio.

With respect to the nonstatutory double patenting rejection, enclosed is a terminal disclaimer.

In view of the foregoing, Applicant respectfully requests reconsideration of the allowability of the claims of the instant application. In addition, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call from him in order to address any outstanding issues and to expedite placement of the application into condition for allowance.

Respectfully submitted,



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